



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,531	03/11/2004	Kurt Brooks Uhler	N0185US	8760
37583 7590 06/09/2009 NAVTEQ NORTH AMERICA, LLC 425 West RANDOLPH STREET SUITE 1200, PATENT DEPT CHICAGO, IL 60606				
EXAMINER				
HU, KANG				
ART UNIT		PAPER NUMBER		
3715				
MAIL DATE		DELIVERY MODE		
06/09/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/798,531

Applicant(s)

UHLIR ET AL.

Examiner

KANG HU

Art Unit

3715

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). 05/13/2009
13. ☐ Other: _____.

/Kathleen Mosser/
Primary Examiner, Art Unit 3715

Continuation of 11, does NOT place the application in condition for allowance because: Applicant's arguments filed on 5/13/2009 have been fully considered but they are not persuasive. The amendment will not be entered because the request for reconsideration is not deemed to place the application in better form for appeal by materially reducing or simplifying the issue for appeal.

The applicant's argument toward USC 101 rejection has been fully considered but they are not persuasive. Claims 29-32 were rejected as being directed to non-statutory subject matter. Claim 29 does not recite a tie to a particular machine or apparatus. The recitation of "using the application programming interface to access the geographic data from a map database," "using the application programming interface to provide the geographic data from the map database in a suitable format to the game engine program," and "presenting a game scenario to a user interface of a computer platform to a user" are merely nominal recitations that do not recite nor require the use of any specific machine or apparatus.

Applicant's argument under 35 U.S.C. 103 has been fully considered but they are not persuasive.

Re claim 1, applicant has argued that a game engine program configured for running on a computer platform and for presenting a computer game scenario to a user via the user interface... is different and patentably distinct from a navigation application program taught by Ashby. Previously, the examiner stated in the final office action dated 3/3/2009 that Ashby does not explicitly state a game engine program configured for running on a computer platform for presenting a game scenario to a user via the user interface, however Ashby teaches of using navigation application program, the navigation application program is analogous to the game engine program because both are software programs for presenting information to the user, the gaming aspect of such program is intended use and does not provide any structural difference.

The applicant has argued that a game engine program is different from a navigation application program because it includes logic, rules, software, and other information specifically for operating and executing different functions of computer game and various play scenarios thereof. The argument is not persuasive as a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The applicant has not pointed out any structural difference between a game engine program and a navigation application program as recited in the claim. The claim itself does not recite any "logic, rules, software, and other information specifically for operating and executing different functions of a computer program and various play scenarios thereof" which makes this point moot.

Re claim 14, the applicant has further argued that the combination of Koller and Radcliffe does not teach or suggest "using the application programming interface program to access the geographic data from a map database", more specifically "geographic data derived from a database suitable for vehicle navigation on roads in real-world geographic locale". The applicant has pointed out that the movement and view point referred to in Koller relates to data representations of vehicles and data representations of road, not a vehicle on a real, physical road, and therefore not the same as data suitable for providing navigation for a vehicle on a real road. The applicant has not pointed out the distinction between the two geographic data, simply making general allegation that the claims define a patentable invention without specifically pointing out how the geographic data of Koller is different from the present invention. The recitation the intended use of using such geographic data in a real-world locale must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Re claim 29, the applicant has further argued that it would not have been obvious to combine the teachings of Ashby with Radcliffe, as Radcliffe would not request road segment data records as recited during operation to present a game scenario. The examiner has previously pointed out in response to argument re claim 1 that the recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. The applicant has not pointed out any structural difference between the two as explained in claim 1.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971)..